

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-19 stand provisionally rejected for double patenting; and
Claims 1-19 stand rejected under 35 USC § 103.

Double Patenting

The provisional double patenting rejection is traversed. The Application/Control number of the instant application is 09/925,649 and the Application/Control No. of the publication cited is 09/925,694. They are, therefore, one and the same application. The double patenting rejection is therefore moot.

Rejections under 35 USC § 103

1) The rejection of claims 1-10, 13-14 and 18-19 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al., is respectfully traversed.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be able to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

In this rejection claim 1 is quoted and sections of Tabata et al. which are alleged to disclose the quoted steps are set forth. However, this analysis of Tabata et al. is incorrect and fails to establish a proper basis for the rejection.

Claim 1 calls for:

A printing method, comprising the steps of:
receiving data at a printer;
detecting a network address in the received data;
if a network address is detected, then displaying or
sending a message notifying of the network
address detection and requesting authorization
to access the network address;
if authorization to access is received, sending on the
Internet or other network an access request for
a document to the network address;
retrieving the document from the network address;
and
printing the document.

IN TABATA ET AL. PRINTER AND SCANNER ARE DIFFERENT DEVICES

The Tabata et al. reference, at column 23, lines 10-12, discloses that a copying machine 470 comprises a scanner unit 470A as a "correlated information identifying unit" and a printer 470B as an "output unit" and that the two units are integrated into one device (viz., the copying machine 470). It is submitted that this reference discloses throughout the document that the scanner and printer are, irrespective of the integration, different devices, and that this disclosure would cause the hypothetical person of ordinary skill to understand that the fact the integration of the two into a single arrangement does not suggest that the scanner is a printer or *vice versa*.

In column
C23/10-12

TABATA ET AL. PRINTER DOES NOT RECEIVE ADDRESS CONTAINING DATA

It is submitted that the disclosure of column 23, lines 56-63, which is relied upon to disclose the first of the steps set forth in claim 1, does not disclose the printer receiving any data. In fact, this section indicates that it is the scanner unit that reads

C23/56
to C24/23

the medium and reads a code area 206 which is on the medium as raster information. More specifically, column 23, lines 56-63, discloses:

Then, the medium form 420 with the **mark(s)** 51 added thereto is **read by the scanner unit** (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the **scanner units** 430, 470A **reads a code area 206 from the medium form 420 as raster information** and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

It is therefore clear that if data, which contains an address, is "received", it is disclosed as being "received" by the scanner and not the printer. This disclosure can be seen as teaching away from the claimed subject matter.

Thus, in a nutshell, the claims call for the printer to receive data which can include certain information such as network address. Tabata et al. teaches the use a scanner which is associated with a printer to receive data inputs, and therefore leads the thinking of hypothetical person of ordinary skill away from using the printer for this purpose. In fact, the disclosure of the Tabata et al. is such as to lead the thinking of the hypothetical person of ordinary skill in the direction that the printer is to be used for just printing and is provided printing information from a server.

CLAIMED REQUEST FOR AUTHORIZATION IS TRIGGERED BY NETWORK ADDRESS IN
DATA RECEIVED BY PRINTER - NOT SCANNER

*Typed and
done*

The independent claims of this application call for an operation wherein if a network address is detected, then a message is either displayed or sent notifying of the network address detection, which requests authorization to access the network address.

Column 24, lines 18-23 are asserted as disclosing the step of sending on the internet an access request for a document to the network address. The rejection does however, acknowledge that Tabata et al. does not "clearly" disclose requesting "authorization" to access the network address and turns to Russell et al. to overcome this admitted shortcoming in disclosure.

However, this section of Tabata et al. discloses:

The file **server** (correlated information file retrieving unit) 440 **retrieves**, when having received an address (URL) of the correlated information file, **an appropriate correlated information file** from the appropriate file device 410 according to the address (URL) of the correlated information file (S2103).

The file **server** transfers the retrieved correlated information file to a **printer** 460 or to a printer 470B (S2104). (Emphasis added)

Thus, in response to being supplied an address from a scanner unit, the server retrieves the file and then sends it to the printer.

PASSWORD WOULD NOT BE OBVIOUS IN CLAIMED ARRANGEMENT

The rejection takes the position that using a password in Tabata et al., and sending this password to a remote administration location would have been obvious at the time of invention in that it would have improved the securing of the system. However, when one considers the concept on which Tabata et al. is based, it is clear that the only way into the system is through a scanner which scans a medium, sends the information derived from the scanning to a file server which is triggered to send the appropriate print instructions to the printer. If there is to be a password it would have to

be incorporated into the medium 210 and the scanner 60 (see Fig. 1) adapted to refuse to scan/transmit if the password was not provided. In this connection the teachings of Russell may be consulted. However, the use of the teachings of Russell et al. would mean that the printer would never be able to respond to this type of password and it would always have to be the scanner which performs this function. The claimed invention, therefore could not be arrived at through the transfer of teachings.

2) The rejection of claims 11 and 12 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

It is submitted that the teachings of Wolff would not overcome the tendency for the teachings of Tabata et al. and Russell et al. to move the thinking of the hypothetical person of ordinary skill, away from the claimed subject matter. Indeed Wolff has been cited only to overcome the admitted shortcoming that Tabata et al. does not disclose/suggest the receipt of data via e-mail.

It is submitted that the system of Tabata et al. does not lend itself readily to internet access and, as noted above, is basically dedicated to scanning data off sheets of medium such as paper, and feeding the data thus obtained to a server for further action such as printing. As noted above, the teachings of Russell et al are such as reinforce this tendency. Hence, the citation of Wolff does not clarify matters and in fact is such as to add confusion as to how an e-mail connection could be introduced into the arrangement disclosed in Tabata et al. without inducing a departure from the basic intentions of Tabata et al.

This rejection is deemed untenable, and is traversed for at least this reason.

3) The rejection of claims 15-17 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

In this rejection, Wolff has been cited only to overcome the admitted shortcoming that Tabata et al. does not disclose printing one document in another and identifying the contents of the documents. It is submitted that even if (*arguedo*) such a feature were to be introduced into the arrangement of Tabata et al. still the data would suggested as being received at the printer and as such the claimed subject matter would not be rendered unpatenatable.

Conclusion

It is submitted that the claims are allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of the claimed subject matter is courteously solicited.

Respectfully submitted,

By



Date February 20, 2004

Telephone: (202) 672-5485
Facsimile: (202) 672-5399

William T. Ellis
Registration No. 26,874

Keith J. Townsend
Registration No. 40,358